REMARKS

The Applicant respectfully requests further examination and reconsideration in view of the amendments above and the arguments set forth fully below. Claims 1, 4-15, 17-24, 49, 52-63, 65-73, 76-87, and 89-96 were previously pending in this application. Within the Office Action, Claims 1, 4-15, 17-24, 49, 52-63, 65-73, 76-87, and 89-96 have been rejected. Accordingly, Claims 1, 4-15, 17-24, 49, 52-63, 65-73, 76-87, and 89-96 are currently pending.

Rejections under 35 U.S.C. §103

Within the Office Action, Claims 1, 4-15, 17-24, 49, 52-63, 65-73, 76-87, and 89-96 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,253,188 issued to Witek et al. (hereafter "Witek") in view of U.S. Patent No. 5,604,772 to Botto et al. (hereinafter "Botto"). The Applicant respectfully disagrees.

Witek teaches a system and method for providing classified ads over the Internet. Internet users can connect to a newspaper web server and central web application server to search for and obtain classified ads. Ad records are stored in ad database servers 20 for providing classified ad records on request to application servers 16. To search the ad records, the search process is divided into two principle parts. The first part includes a system entry and pre-selection sequence, and the second part includes a record selection sequence. [Witek, col. 12, lines 10-13] More specifically, in the first part the user enters the system and specifies the category of classified ads to be searched. Thereafter, as the user navigates to the respective selected category, the user further specifies a subcategory for the particular category selected. [Witek, col. 12, lines 27-37] The selected category and subcategory pair is identified by a category/subcategory ID 46. The specific parameters are entered as primary selection parameters 60 and as secondary selection parameters 62. The first part of the search process is limited to performing searches based on category, or in other words a hierarchical search. [Witek, col. 13, lines 30-46] During this first *utilization* of the search system of Witek, the user is *only* able to specify a category and subcategory pair. The second part of the search process is limited to performing searches based on entered parameters, in other words keyword search or parametric search. During this second *utilization* of the search system of Witek, the user is *only* able to perform searches based on entered parameters.

As discussed above, Witek teaches that the user first navigates through the system and specifies a category and subcategory to narrow down the number of records to search. [Witek,

col. 12, lines 27-37] According to the teachings of Witek, during this first part of the search process, only the category and subcategory search methodologies are available. Witek then teaches that the second part of the search process includes entering a formal record selection query containing the specific parameters for the ad records the user wishes to see. [Witek, col. 17, lines 42-50] No other search methodologies are available during the second part of the search process. Witek does not teach that during the first part or the second part of the search process, each of the search methodologies are available. Accordingly, Witek does not teach that each utilization of the search module includes the availability of all types of available searches.

As recognized within the Office Action, Witek does not teach a dichotomous key search. Witek does not teach performing a search in which for any given searching step, at any location within the database, three or more different search methodologies are available to be used to perform the search. Specifically, Witek does not teach that three or more of any of a keyword search, hierarchical search, dichotomous key search and parametric search can be used at any location within the database. As discussed above, Witek teaches that during the first part of the search process only the category and subcategory are specified and during the second part of the search process only searches based on entered parameters are available.

Botto teaches a transmission system and modem utilizing coded modulation. Botto appears to be cited because of its teaching of a zone searching module which determines a searched zone by dichotomy. Botto also does not teach performing a search in which for any given searching step, at any location within the database, three or more different search methodologies are available to be used to perform the search. There is no motivation to warrant the combination of Witek and Botto. There is no hint, teaching or suggestion in either of Witek or Botto to warrant their combination.

This is a classic case of impermissibly using hindsight to make a rejection based on obviousness. The Court of Appeals for the Federal Circuit has stated that "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In Re Fritch, 972 F.2d, 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). As discussed above, Witek and Botto do not teach performing a search in which for any given searching step, at any location within the database, three or more different search methodologies are available to be used to perform the search, as claimed. As recognized within the Office Action, Witek does not teach a dichotomous key search. Botto does teach a zone searching module which determines a searched zone by dichotomy. Within the Office Action, it is stated that

> [i]t would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Botto into the invention of Witek because the combination would reduce the memory access when using binary search, and providing user more search methodologies. [Office Action, page 4]

It is only with the benefit of the present claims, as a "template" that there is any motivation to combine the data modem of Botto with the classified ad system of Witek. No such motivation can be found in the teachings of either of the references. To conclude that the combination of Witek and Botto is obvious, based on the teachings of these references, is to use hindsight based on the teachings of the present invention and to read much more into Witek and Botto than their actual teachings. This is simply not permissible based on the directive from the Court of Appeals for the Federal Circuit.

It is well settled that to establish a *prima facie* case of obviousness, three basic criteria must be met:

1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2) there must be a reasonable expectation of success; and
3) the prior art reference, or references, must teach or suggest all the claim limitations. MPEP § 2143.

The burden of establishing a *prima facie* case of obviousness based on the teachings of Witek and Botto has not been met within the Office Action.

There is no motivation to combine the teachings of Botto with Witek. Botto relates to a transmission system and modem utilizing coded modulation. Botto teaches that the zone searching module determines the zone of the reference quadrant by dichotomy according to an algorithm. [Botto, col. 5, lines 26-29] Botto is only cited because it teaches searching by dichotomy. There is no hint, teaching or suggestion in either Botto or Witek to motivate one skilled in the art to combine their teachings. It is only with the benefit of the presently claimed invention as a "template" that one would consider combining the dichotomous search of Botto with the classified ad system of Witek.

Even if considered proper, the combination of Witek and Botto does not teach performing a search in which for any given searching step, at any location within the database, three or more different search methodologies are available to be used to perform the search. Neither, Witek, Botto nor their combination teach that each utilization of the search modules

includes the availability of three or more of the keyword search, the hierarchical search, the dichotomous key search and the parametric search.

In contrast to the teachings of Witek and Botto, the method of and apparatus for performing a research task of the present invention, interchangeably utilizes a multitude of search methodologies. Specifically, utilizing a search module, a user is able to selectively utilize one or more search methodologies including keyword search, hierarchical search, dichotomous key search and parametric search to correlate a search criteria to a searchable database for generating one or more matching items. It is further taught within the present specification that

> [a]t each node within the tree, the user is presented with the option of using any one or combinations of the four search methodologies utilized by the research system. The four search methodologies are keyword search, hierarchical tree search, dichotomous key search, and parametric search. Regardless as to which search methodology or search methodologies are used to reach a particular node, the user can utilize any of the four search methodologies to further refine the search and move further down the directory tree structure. The user may also navigate back up the directory tree structure to a higher node, and once again have the option to use any of the four search methodologies to refine the search from the current node and move further down the directory tree structure. [Present Specification, page 39, line 32 page 40, line 8].

Therefore, a user is able to navigate the directory tree structure, utilizing any one of the search methodologies in any combination to reach the desired result. As discussed above, neither Witek, Botto nor their combination teach that each utilization of the search module includes the availability of the keyword search, the hierarchical search, the dichotomous key search and the parametric search.

Within the Response to Arguments section of the Office Action, it is stated that

> Applicant also does not clearly claim "at any step location within the database, three or more different methodologies are available to be used to perform the search." Instead, Applicant only claims that "wherein each utilization of the search module includes the availability of each search." Therefore, if the Witek discloses one of the methods and the method is available for the search process, then the Witek still can apply to the invention. [Office Action, pages 6 and 7]

The Applicant respectfully disagrees. It is specified within the claims that the search module includes three of a keyword search, a hierarchical search, a dichotomous key search and a parametric search. This limitation requires that ***all three*** of the specified search capabilities are

present within the search module. In order to properly be applied to the claimed invention, the cited reference(s) must teach or make obvious ***all three*** of the specified search capabilities. It is further specified within the claims that each utilization of the search module includes the availability of the three or more specified searches. Utilization is defined as "to put to use for a certain purpose." [The American Heritage Dictionary] Just as taught within the specification, the limitation that each utilization of the search module includes the availability of the three or more specified searches, specifies that *every time* the search module is used, each of the three or more specified search capabilities (three of: keyword search, hierarchical search, dichotomous key search and parametric search) are available. Neither Witek, Botto nor their combination teach such a search module. As discussed above, neither Witek, Botto nor their combination teach that each utilization of the search module includes the availability of three or more of the keyword search, the hierarchical search, the dichotomous key search and the parametric search.

The independent Claim 1 is directed to a method of performing a research task within a searchable database. The method of Claim 1 comprises the steps of utilizing a search module to correlate a search criteria to the searchable database for generating one or more matching items, wherein each matching item corresponds to a segment of the searchable database, further wherein the search module includes a keyword search, a hierarchical search, and a dichotomous key search, utilizing the search module to correlate a subsequent search criteria to one of the matching items for generating one or more subsequent matching items, wherein each subsequent matching item is a sub-segment of the matching item used to generate the subsequent matching item, and further wherein the subsequent search criteria is a selective one of the search criteria and a different search criteria, and repeating the step of utilizing the search module to correlate a subsequent search criteria until the research task is completed *such that each utilization of the search module includes the availability of the keyword search, the hierarchical search, and the dichotomous key search*. As described above, the combination of Witek and Botto is not proper. As further discussed above, even if considered proper, neither Witek, Botto nor their combination teach that each utilization of the search module includes the availability of the keyword search, the hierarchical search and the dichotomous key search. For at least these reasons the independent Claim 1 is allowable over the teachings of Witek, Botto and their combination.

Claims 4-14 depend on the independent Claim 1. As described above, the independent Claim 1 is allowable over the teachings of Witek, Botto and their combination. Accordingly, Claims 4-14 are all also allowable as being dependent on an allowable base claim.

The independent Claim 15 is directed to research system for performing a research task within a searchable database. The research system of Claim 15 comprises a research server configured to utilize a search module, to correlate a search criteria to the searchable database coupled to the research server for generating one or more matching items, wherein each matching item corresponds to a segment of the searchable database, further wherein the search module includes a keyword search, a hierarchical search, and a dichotomous key search, to utilize the search module to correlate a subsequent search criteria to one of the matching items for generating one or more subsequent matching items, wherein each subsequent matching item is a sub-segment of the matching item used to generate the subsequent matching item, further wherein the subsequent search criteria is a selective one of the search criteria and a different search criteria, and to repeat the utilization of the search module to correlate a subsequent search criteria to one of the matching items for generating one or more subsequent matching items, wherein each subsequent matching item is a sub-segment of the matching item used to generate the subsequent matching item, further wherein the subsequent search criteria is a selective one of the search criteria and a different search criteria, until the research task is completed, and further wherein *each utilization of the search module includes the availability of the keyword search, the hierarchical search, and the dichotomous key search.* As described above, the combination of Witek and Botto is not proper. As further discussed above, even if considered proper, neither Witek, Botto nor their combination teach that each utilization of the search module includes the availability of the keyword search, the hierarchical search and the dichotomous key search. For at least these reasons, the independent Claim 15 is allowable over the teachings of Witek, Botto and their combination.

Claims 17-24 depend on the independent Claim 15. As described above, the independent Claim 15 is allowable over the teachings of Witek, Botto and their combination. Accordingly, Claims 17-24 are all also allowable as being dependent on an allowable base claim.

The independent Claim 49 is directed to method of performing a research task within a searchable database. The method of Claim 49 comprises the steps of utilizing a search module to correlate a search criteria to the searchable database for generating one or more matching items, wherein each matching item corresponds to a segment of the searchable database, further

wherein the search module includes a keyword search, a dichotomous key search, and a parametric search, utilizing the search module to correlate a subsequent search criteria to one of the matching items for generating one or more subsequent matching items, wherein each subsequent matching item is a sub-segment of the matching item used to generate the subsequent matching item, and further wherein the subsequent search criteria is a selective one of the search criteria and a different search criteria, and repeating the step of utilizing the search module to correlate a subsequent search criteria until the research task is completed *such that each utilization of the search module includes the availability of the keyword search, the dichotomous key search, and the parametric search.* As described above, the combination of Witek and Botto is not proper. As further discussed above, even if considered proper, neither Witek, Botto nor their combination teach that each utilization of the search module includes the availability of the keyword search, the dichotomous key search, and the parametric search. For at least these reasons, the independent Claim 49 is allowable over the teachings of Witek, Botto and their combination.

Claims 52-62 depend on the independent Claim 49. As described above, the independent Claim 49 is allowable over the teachings of Witek, Botto and their combination. Accordingly, Claims 52-62 are all also allowable as being dependent on an allowable base claim.

The independent Claim 63 is directed to a research system for performing a research task within a searchable database. The research system of Claim 63 comprises a research server configured to utilize a search module to correlate a search criteria to the searchable database coupled to the research server for generating one or more matching items, wherein each matching item corresponds to a segment of the searchable database, further wherein the search module includes a keyword search, a dichotomous key search, and a parametric search, to utilize the search module to correlate a subsequent search criteria to one of the matching items for generating one or more subsequent matching items, wherein each subsequent matching item is a sub-segment of the matching item used to generate the subsequent matching item, further wherein the subsequent search criteria is a selective one of the search criteria and a different search criteria, and to repeat the utilization of the search module to correlate a subsequent search criteria to one of the matching items for generating one or more subsequent matching items, wherein each subsequent matching item is a sub-segment of the matching item used to generate the subsequent matching item, and further wherein the subsequent search criteria is a selective one of the search criteria and a different search criteria, until the research task is completed, and

further wherein *each utilization of the search module includes the availability of the keyword search, the dichotomous key search, and the parametric search.* As described above, the combination of Witek and Botto is not proper. As further discussed above, even if considered proper, neither Witek, Botto nor their combination teach that each utilization of the search module includes the availability of the keyword search, the dichotomous key search, and the parametric search. For at least these reasons, the independent Claim 63 is allowable over the teachings of Witek, Botto and their combination.

Claims 65-72 depend on the independent Claim 63. As described above, the independent Claim 63 is allowable over the teachings of Witek, Botto and their combination. Accordingly, Claims 65-72 are all also allowable as being dependent on an allowable base claim.

The independent Claim 73 is directed to a method of performing a research task within a searchable database. The method of Claim 73 comprises the steps of utilizing a search module to correlate a search criteria to the searchable database for generating one or more matching items, wherein each matching item corresponds to a segment of the searchable database, further wherein the search module includes a hierarchical search, a dichotomous key search, and a parametric search, utilizing the search module to correlate a subsequent search criteria to one of the matching items for generating one or more subsequent matching items, wherein each subsequent matching item is a sub-segment of the matching item used to generate the subsequent matching item, and further wherein the subsequent search criteria is a selective one of the search criteria and a different search criteria, and repeating the step of utilizing the search module to correlate a subsequent search criteria until the research task is completed *such that each utilization of the search module includes the availability of the hierarchical search, the dichotomous key search, and the parametric search.* As described above, the combination of Witek and Botto is not proper. As further discussed above, even if considered proper, neither Witek, Botto nor their combination teach that each utilization of the search module includes the availability of the hierarchical search, the dichotomous key search, and the parametric search. For at least these reasons the independent Claim 73 is allowable over the teachings of Witek, Botto and their combination.

Claims 76-86 depend on the independent Claim 73. As described above, the independent Claim 73 is allowable over the teachings of Witek, Botto and their combination. Accordingly, Claims 76-86 are all also allowable as being dependent on an allowable base claim.

The independent Claim 87 is directed to a research system for performing a research task within a searchable database. The research system of Claim 87 comprises a research server configured to utilize a search module to correlate a search criteria to the searchable database coupled to the research server for generating one or more matching items, wherein each matching item corresponds to a segment of the searchable database, further wherein the search module includes a hierarchical search, a dichotomous key search, and a parametric search, to utilize the search module to correlate a subsequent search criteria to one of the matching items for generating one or more subsequent matching items, wherein each subsequent matching item is a sub-segment of the matching item used to generate the subsequent matching item, further wherein the subsequent search criteria is a selective one of the search criteria and a different search criteria, and to repeat the utilization of the search module to correlate a subsequent search criteria to one of the matching items for generating one or more subsequent matching items, wherein each subsequent matching item is a sub-segment of the matching item used to generate the subsequent matching item, and further wherein the subsequent search criteria is a selective one of the search criteria and a different search criteria, until the research task is completed, and further wherein *each utilization of the search module includes the availability of the hierarchical search, the dichotomous key search, and the parametric search.* As described above, the combination of Witek and Botto is not proper. As further discussed above, even if considered proper, neither Witek, Botto nor their combination teach that each utilization of the search module includes the availability of the hierarchical search, the dichotomous key search, and the parametric search. For at least these reasons the independent Claim 87 is allowable over the teachings of Witek, Botto and their combination.

Claims 89-96 depend on the independent Claim 87. As described above, the independent Claim 87 is allowable over the teachings of Witek, Botto and their combination. Accordingly, Claims 89-96 are all also allowable as being dependent on an allowable base claim.

For the reasons given above, Applicant respectfully submits that the claims are now in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, she is encouraged to call the undersigned attorney at (408) 530-9700.

Respectfully submitted,
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CERTIFICATE OF MAILING (37 CFR 1.8(a))

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